

Atty. Dkt. No. 035451-0132 (3645.Palm)

**REMARKS**

Applicant respectfully requests entry of the foregoing amendments under 37 C.F.R. § 1.116 and favorable reconsideration of the application in view of the reasons that follow. Because this response is being submitted within (2) months of the mailing date of the Office Action, a prompt Advisory Action is requested in the event that this reply is not found to place the present application in condition for allowance.

Claims 1-22 are currently pending in the application.

Claim 18 is requested to be amended. No new matter is added.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier for each claim.

If the foregoing amendments are entered, claims 1-22 will remain pending in this application.

**Specification**

In the specification, paragraph [0031] starting on page 9, paragraph [0037] on page 11, and paragraph [0039] starting on page 11 have been amended to provide further clarity in the application. No new matter has been added.

**Claim Rejections – 35 U.S.C. § 103(a)**

In section 2 of the Office Action, claims 1-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Henry, Jr. (U.S. Patent No. 5,881,169) in view of Cooper (U.S. Patent No. 5,006,836).

Atty. Dkt. No. 035451-0132 (3645 Palm)

a. Claims 1-7

Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness with regard to claim 1 because there is no suggestion or motivation to modify Henry, Jr. or to otherwise combine the teachings of Henry, Jr. and Cooper to arrive at the subject matter of claim 1. The Office Action acknowledges with regard to claim 1 that Henry, Jr. does not teach that “the deformable side is deformed and the switch is toggled” and that the “squeezing and unsqueezing” taught by Cooper “is not the same as toggling the switch each time the deformable side is deformed.” To address this acknowledged deficiency in the cited combination of Henry, Jr. and Cooper, the Office Action merely cites Danielson et al. (U.S. Patent No. 5,805,474) in support of the proposition that “switch 21 or 22 [in Cooper] could easily [be] modified to work as a toggle switch.” The Office Action concludes that “one would realize that, by incorporating Cooper’s flexible wall portion and corresponding pressure operated switch in Henry’s invention, an intuitive and ergonomic switching function is provided for text information entry.”

Applicant submits that no such suggestion or motivation based on “an intuitive and ergonomic switching function” exists in the cited combination of Henry, Jr. and Cooper (and the toggle switch of Danielson et al.) to modify or otherwise combine the teachings of these references to somehow arrive at the handheld computer system of claim 1, including the toggling function of the pressure sensitive switch coupled to the deformable side. For example, Cooper teaches only generally that “the signals generated by the squeezing and unsqueezing of the mouse can be used for any purpose by the computer.” Col. 2, lines 59-61. Moreover, the mouse and computer of Cooper are only taught as separate devices with the mouse being configured to independently operate when resting on a surface. Col. 1, lines 54-56. Cooper provides no suggestion of the desirability of integrating the “squeezing and unsqueezing” features of the disclosed mouse with the handheld computer and text input/character selection fields of Henry, Jr. to obtain intuitive or ergonomic benefits in a single device operated in the hand of a user.

Atty. Dkt. No. 035451-0132 (3645.Palm)

Furthermore, the Office Action does not provide any recitation as to why one of ordinary skill in the art would be motivated to modify the switches 21 and 22 disclosed in Cooper to work as a toggle switch (such as the toggle switch taught by Danielson et al.) in combination with the handheld computer of Henry, Jr. in order to somehow arrive at the subject matter of claim 1. The Office Action states only that toggling the switch "is a well-known variation." In the absence of a recitation of a motivation to modify the switches 21 and 22 disclosed in Cooper to work as a toggle switch (such as the toggle switch taught by Danielson et al.), the rejection of claim 1 is improper. See Manual of Patent Examining Procedure § 2143.01.

In fact, Applicant submits that the rejection of claim 1 under 35 U.S.C. § 103(a) is also improper because to modify the switches disclosed in Cooper to work as a toggle switch would change the principle of operation of Cooper. As such, there would be no motivation to modify the switches disclosed in Cooper to work as a toggle switch. See Manual of Patent Examining Procedure § 2143.01. Viewed as a whole, Cooper teaches that "[u]sing the mouse with the above described program, an operator has a perception like that of moving his hand to a form shown on the screen, grasping it, moving it, and then releasing it in a new position," and that "[t]his perception makes the manipulation of the mouse control very easy to learn and remember, and gives a sense of satisfaction in performing the operation." Col. 2, lines 61-67. To modify the switches disclosed in Cooper to work as a toggle switch would change the intuitive grasp/move/release principle under which Cooper was designed to operate.

Applicants further submit that providing the switching features taught by either Cooper or Danielson et al. in combination with a mouse or other separate interface device in no way provides, suggests, or otherwise implicates the innovation and advantages of the handheld computer system of claim 1, including the toggling function of the pressure sensitive switch coupled to the deformable side. Applicant's claimed combination of the toggling function of the pressure sensitive switch coupled to the deformable side with the other elements of claim 1 provides the advantage of an interface and a handheld computer in a single device and represents a significant innovation over providing the switching features taught by either Cooper or

Atty. Dkt. No. 035451-0132 (3645.Palm)

Danielson et al. in combination with a mouse or other separate interface device separate from the computer. Contrary to conventional wisdom, Applicant has taken the handheld computer itself and integrated user interface toggle switches into it as opposed to putting the toggle switches on a user interface. This design advantageously makes the handheld computer housing part of the user interface. This is a very different concept from having a separate user interface.

Thus, the combined teachings of Henry, Jr. and Cooper are not sufficient to render the subject matter of claim 1 *prima facie* obvious because there is no suggestion or motivation to combine the teachings of these or any other references to somehow arrive at the subject matter of claim 1. Any suggestion or motivation to combine or otherwise modify the teachings of Henry, Jr. and Cooper has been taken from Applicant's own disclosure using hindsight, which is improper. Accordingly, Applicant requests that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 2-7 depend from claim 1, and are thus patentable over the cited combination of references for at least the same reasons, and Applicant further requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn as well.

**b. Claims 8-17**

Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness with regard to claim 8 because there is no suggestion or motivation to modify Henry, Jr. or to otherwise combine the teachings of Henry, Jr. and Cooper to arrive at the subject matter of claim 8. The Office Action acknowledges with regard to claim 8 that Henry, Jr. does not teach that "the deformable side is deformed and the switch is toggled" and that the "squeezing and unsqueezing" taught by Cooper "is not the same as toggling the switch each time the deformable side is deformed." To address this acknowledged deficiency in the cited combination of Henry, Jr. and Cooper, the Office Action merely cites Danielson et al. (U.S. Patent No. 5,805,474) in support of the proposition that "switch 21 or 22 [in Cooper] could easily [be] modified to work as a toggle switch." The Office Action concludes that "one would realize that, by incorporating Cooper's flexible wall portion and corresponding pressure operated switch

Atty. Dkt. No. 035451-0132 (3645.Palm)

in Henry's invention, an intuitive and ergonomic switching function is provided for text information entry."

Applicant submits that no such suggestion or motivation based on "an intuitive and ergonomic switching function" exists in the cited combination of Henry, Jr. and Cooper (and the toggle switch of Danielson et al.) to modify or otherwise combine the teachings of these references to somehow arrive at the user interface for a handheld computer system of claim 8, including the toggling function of the means for activating and deactivating coupled to the deformable side of the housing. For example, Cooper teaches only generally that "the signals generated by the squeezing and unsqueezing of the mouse can be used for any purpose by the computer." Col. 2, lines 59-61. Moreover, the mouse and computer of Cooper are only taught as separate devices with the mouse being configured to independently operate when resting on a surface. Col. 1, lines 54-56. Cooper provides no suggestion of the desirability of integrating the "squeezing and unsqueezing" features of the disclosed mouse with the handheld computer and text input/character selection fields of Henry, Jr. to obtain intuitive or ergonomic benefits in a single computing device held and operated in the hand of a user.

Furthermore, the Office Action does not provide any recitation as to why one of ordinary skill in the art would be motivated to modify the switches 21 and 22 disclosed in Cooper to work as a toggle switch (such as the toggle switch taught by Danielson et al.) in combination with the handheld computer of Henry, Jr. in order to somehow arrive at the subject matter of claim 8. The Office Action states only that toggling the switch "is a well-known variation." In the absence of a recitation of a motivation to modify the switches 21 and 22 disclosed in Cooper to work as a toggle switch (such as the toggle switch taught by Danielson et al.), the rejection of claim 8 is improper. See Manual of Patent Examining Procedure § 2143.01.

In fact, Applicant submits that the rejection of claim 8 under 35 U.S.C. § 103(a) is also improper because to modify the switches disclosed in Cooper to work as a toggle switch would change the principle of operation of Cooper. As such, there would be no motivation to modify the switches disclosed in Cooper to work as a toggle switch. See Manual of Patent Examining

Atty. Dkt. No. 035451-0132 (3645.Palm)

Procedure § 2143.01. Viewed as a whole, Cooper teaches that “[u]sing the mouse with the above described program, an operator has a perception like that of moving his hand to a form shown on the screen, grasping it, moving it, and then releasing it in a new position,” and that [t]his perception makes the manipulation of the mouse control very easy to learn and remember, and gives a sense of satisfaction in performing the operation.” Col. 2, lines 61-67. To modify the switches disclosed in Cooper to work as a toggle switch would change the intuitive grasp/move/release principle under which Cooper was designed to operate.

Thus, the combined teachings of Henry, Jr. and Cooper are not sufficient to render the subject matter of claim 8 *prima facie* obvious because there is no suggestion or motivation to combine the teachings of these or any other references to somehow arrive at the subject matter of claim 8. Any suggestion or motivation to combine or otherwise modify the teachings of Henry, Jr. and Cooper has been taken from Applicant’s own disclosure using hindsight, which is improper. Accordingly, Applicant requests that the rejection of claim 8 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 9-17 depend from claim 8, and are thus patentable over the cited combination of references for at least the same reasons, and Applicant further requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn as well.

**c. Claims 18-22**

With regard to claim 18, Applicant respectfully submits that the cited combination of Henry, Jr. in view of Cooper fails to teach, disclose, or suggest all of the steps of claim 18 as combined therein. Specifically, claim 18 has been amended to recite “wherein the deformable side is opposite a non-deformable side of the handheld computer.” The cited combination of Henry, Jr. in view of Cooper does not teach, disclose, or suggest “wherein the deformable side is opposite a non-deformable side of the handheld computer” as included in the combination of steps of claim 18. For example, Cooper teaches only that:

Periphery cover 18 includes vertical wall 29 with outward facing digit-engaging portions 30 and 31 in opposed positions on the vertical wall so that they can receive a squeezing force applied by

Atty. Dkt. No. 035451-0132 (3645.Palm)

two digits of an operator who is grasping the mouse controller in his hand. The wall 29 is resiliently flexible so that when it is squeezed between portions 30, 31 it moves inward and presses against operating mechanisms 26, 27 of switches 21, 22.

Col. 2, lines 2-11. Cooper also teaches that "[s]ince switches 21 and 22 are connected in series they may be considered together as a single composite switch which is closed if both are closed and otherwise open." As such, Cooper discloses the use of two opposite flexible wall portions to activate a single composite switch. Thus, the cited combination of Henry, Jr. in view of Cooper does not teach, disclose, or suggest "wherein the deformable side is opposite a non-deformable side of the handheld computer," and particularly not as part of a "method of interfacing with a handheld computer system" when combined with the other steps of claim 18. Accordingly, Applicant requests that the rejection of claim 18 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 19-22 depend from claim 18 and are thus patentable over the cited combination of references for at least the same reasons as claim 18, and Applicant further requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn as well.

### Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

Atty. Dkt. No. 035451-0132 (3645.Palm)

If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 9/23/2005

FOLEY & LARDNER LLP  
Customer Number: 26371  
Telephone: (414) 297-5554  
Facsimile: (414) 297-4900

By Chad E. Bement

Chad E. Bement  
Attorney for Applicant  
Registration No. 54,991